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# CUTTING OUT THE MIDDLEMAN: WHY “LOOK AND FEEL” SHOULD BE IGNORED IN TRADE DRESS LAW

NICHOLAS DiMARINO<sup>†</sup>

## INTRODUCTION

Imagine opening a chain of Mexican restaurants. To create an authentic feel, you construct a stucco building with outdoor and indoor seating, with Mexican-flag-themed interior walls painted green, red, and white, and decorated with Mexican artifacts, along with a mariachi band playing in the background. The restaurant is a success, and, after remaining open for several years, customers have begun to identify the unique décor with your restaurant. But, to your dismay, a new restaurant eventually opens down the street and copies the stucco, paint, decorations, and band. It is easy to see why “the composite tapestry of visual effects” of your restaurant should be protected.<sup>1</sup> After all, you worked hard so that customers would readily identify that specific atmosphere with your restaurant, rather than confuse it with others. Luckily, section 43(a) of the Lanham Act may protect the trade dress of your restaurant.<sup>2</sup>

While this is a more traditional example of trade dress infringement, courts have recently allowed trade dress claims based on the overall “look and feel” of websites.<sup>3</sup> The issue, however, is that claiming that the overall “look and feel” of a

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<sup>1</sup> *Sleep Sci. Partners v. Lieberman*, No. 09-04200 CW, 2010 WL 1881770, at \*3 (N.D. Cal. May 10, 2010) (quoting *Clicks Billiards Inc. v. Sixshooters Inc.*, 251 F.3d 1252, 1259 (9th Cir. 2001)) (internal quotation mark omitted).

<sup>2</sup> 15 U.S.C. § 1125(a)(1)(A) (2012); see *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765, 776 (1992) (giving a taco restaurant, which the fact pattern above was loosely based on, trade dress protection).

<sup>3</sup> *Blue Nile, Inc. v. Ice.com, Inc.*, 478 F. Supp. 2d 1240, 1246 (W.D. Wash. 2007) (internal quotation marks omitted) (failing to dismiss a trade dress claim based on the “look and feel” of the plaintiff's website).

website constitutes protectable trade dress is virtually identical to claiming traditional trade dress, which has been defined as the "composite tapestry of visual effects."<sup>4</sup> Thus, "look and feel" seems to be a way for plaintiffs to claim that their websites have protectable trade dress without actually describing it to courts or defendants.<sup>5</sup> Several district courts have succumbed to this approach by allowing "look and feel" claims in the courthouse door.<sup>6</sup> This Note seeks to provide guidance to courts on how to properly handle trade dress claims for websites.

The purpose of allowing trade dress protection under the Lanham Act is to "prevent[] deception and unfair competition."<sup>7</sup> But allowing generic and vague claims of "look and feel" undermines this purpose by granting unregistered protection without requiring plaintiffs to have a unique or articulable trade dress.<sup>8</sup> Thus, this Note proposes that courts should reject the "look and feel" analysis and evaluate website trade dress claims as if they were standard trade dress claims.

Part I of this Note discusses the background and elements of general trade dress law. Part II discusses the narrower issue of "look and feel" in the context of websites and outlines how courts have currently addressed the "look and feel" issue. Part III proposes that courts ignore the artificial "look and feel" distinction and instead apply normal trade dress analyses and elements. This solution, which requires that courts adhere to a workable standard that serves the underlying purpose of trade dress law, allows recognition of the distinctive characteristics of

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<sup>4</sup> *Sleep Sci.*, 2010 WL 1881770, at \*3 (quoting *Clicks Billiards*, 251 F.3d at 1259) (internal quotation mark omitted).

<sup>5</sup> *Id.* (dismissing the plaintiffs complaint for lack of specificity, as the plaintiff merely alleged its trade dress was the "unique look and feel" of its websites, while offering only what several aspects of its website were, rather than describing how they came together to create protectable trade dress (internal quotation marks omitted)).

<sup>6</sup> *See, e.g.*, *Conference Archives, Inc. v. Sound Images, Inc.*, Civil No. 3:2006-76, 2010 WL 1626072, at \*14 (W.D. Pa. Mar. 31, 2010) (allowing a claim based on "look and feel").

<sup>7</sup> *Two Pesos*, 505 U.S. at 773.

<sup>8</sup> *See Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 380 (2d Cir. 1997).

website trade dress claims, while reducing the risk of “overprotection” by keeping vague and generic terms, like “look and feel,” out of the calculation.<sup>9</sup>

## I. BACKGROUND OF TRADE DRESS LAW

### A. *The Definition of Trade Dress*

Trade dress is the overall image or appearance of a product or object that helps identify it to the consumer.<sup>10</sup> “Traditionally, ‘trade dress’ was thought to consist only of the appearance of labels, wrappers and containers used in packaging the product. However, in modern parlance, ‘trade dress’ includes the total look of a product and its packaging and even includes the design and shape of the product itself.”<sup>11</sup> This includes “features such as size, shape, color, color combinations, texture [and] graphics.”<sup>12</sup> Trade dress does not encompass just the individual elements of a product’s design, but the “overall visual impression that the combination and arrangement of those elements create.”<sup>13</sup> Thus, “[t]rade dress is the composite tapestry of visual effects.”<sup>14</sup>

Trade dress protection stems from section 43(a) of the Lanham Act, which prohibits any person from:

[Using] in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection,

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<sup>9</sup> 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8:3 (4th ed. 2013).

<sup>10</sup> *Id.* § 8:4 (discussing how different circuit courts have defined trade dress).

<sup>11</sup> *Id.* (footnote omitted); *see also* Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 209 (2000) (“[Trade dress] originally included only the packaging, or ‘dressing,’ of a product, but in recent years has been expanded by many Courts of Appeals to encompass the design of a product.”). Examples of trade dress include book and magazine covers, designs of jewelry, clothing, and shoes, and shapes of cars and flashlights. *See* MCCARTHY, *supra* note 9, § 8:4.50.

<sup>12</sup> *CytoSport, Inc. v. Vital Pharm., Inc.*, 617 F. Supp. 2d 1051, 1077 (E.D. Cal. 2009) (quoting *Clicks Billiards Inc. v. Sixshooters Inc.*, 251 F.3d 1252, 1257 (9th Cir. 2001) (internal quotation mark omitted), *aff’d*, 348 F. App’x 288 (9th Cir. 2009)).

<sup>13</sup> *Sleep Sci. Partners v. Lieberman*, No. 09-04200 CW, 2010 WL 1881770, at \*3 (N.D. Cal. May 10, 2010) (quoting *Clicks Billiards*, 251 F.3d at 1259) (internal quotation mark omitted).

<sup>14</sup> *Id.* (quoting *Clicks Billiards*, 251 F.3d at 1259) (internal quotation marks omitted).

or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . .<sup>15</sup>

The original Lanham Act was passed in 1946,<sup>16</sup> but the current framework comes from a 1988 amendment.<sup>17</sup> The general purpose of the Act's trade dress provisions are to "promote fair competition and provide an incentive for registration,"<sup>18</sup> and to "secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers."<sup>19</sup> Thus, trade dress protection is not given to generic or common designs, as that could "hamper efforts to market competitive goods" by allowing unregistered protection to everyday designs.<sup>20</sup> This is especially important because trade dress does not need to be registered to receive Lanham Act protection, broadening the field of those that may take advantage of it.<sup>21</sup>

A classic example of trade dress comes from *Two Pesos, Inc. v. Taco Cabana, Inc.*<sup>22</sup> There, a Mexican restaurant received protection for its trade dress, which included the "eating atmosphere," "dining and patio areas decorated with artifacts, bright colors, paintings and murals," and the "color scheme" of the exterior of the building.<sup>23</sup> Further examples include a bourbon distillery receiving protection for the "red dripping wax seal" on its bottle<sup>24</sup> and the design of the iPhone 3G.<sup>25</sup>

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<sup>15</sup> 15 U.S.C. § 1125(a)(1)(A) (2012).

<sup>16</sup> Lanham Act, Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified as amended in scattered sections of 15 U.S.C. § 1051 *et seq.* (2012)).

<sup>17</sup> Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935 (1988).

<sup>18</sup> 145 Cong. Rec. S8205 (daily ed. July 12, 1999) (statement of Sen. Reid).

<sup>19</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992) (quoting *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985)) (internal quotation mark omitted).

<sup>20</sup> *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 380 (2d Cir. 1997).

<sup>21</sup> *Conference Archives, Inc. v. Sound Images, Inc.*, Civil No. 3:2006-76, 2010 WL 1626072, at \*10 (W.D. Pa. Mar. 31, 2010).

<sup>22</sup> 505 U.S. 763 (1992).

<sup>23</sup> *Id.* at 765.

<sup>24</sup> *Maker's Mark Distillery, Inc. v. Diageo N. Am., Inc.*, 703 F. Supp. 2d 671, 683, 687 (W.D. Ky. 2010) (emphasis omitted), *aff'd*, 679 F.3d 410 (6th Cir. 2012).

<sup>25</sup> *Apple, Inc. v. Samsung Elecs. Co.*, 920 F. Supp. 2d 1079, 1095-1097 (N.D. Cal. 2013).

### B. *The Elements of Trade Dress*

A claim for trade dress infringement must satisfy three elements. A plaintiff must prove that: (1) the trade dress is distinctive; (2) there is a likelihood of confusion between the plaintiff's good and the defendant's good; and (3) the trade dress is non-functional.<sup>26</sup>

For trade dress to be distinctive, it must be inherently distinctive or "ha[ve] acquired distinctiveness through secondary meaning."<sup>27</sup> Inherently distinctive means that the "intrinsic nature [of the trade dress] serves to identify a particular source."<sup>28</sup> In other words, the trade dress naturally tells the consumer that a particular source produces, creates, or sells that product. For example, the Second Circuit Court of Appeals held that the trade dress of the Toilet Bank toy, including its triangular box and red arrows, was inherently distinctive because the "impression" created by all its elements identified its source.<sup>29</sup> Conversely, secondary meaning is established when, "in the minds of the public, the primary significance of a [dress] is to identify the source of the product rather than the product itself."<sup>30</sup> For instance, the Second Circuit held that the Tank Francaise watch had acquired secondary meaning. The court based its decision on a consumer survey, which showed that sixty percent of consumers recognized the watch as being made by Cartier.<sup>31</sup> Once distinctiveness is established, a trade dress plaintiff must then show likelihood of confusion.<sup>32</sup>

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<sup>26</sup> *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 115–16 (2d Cir. 2001) (citing *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 210 (2000)).

<sup>27</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992).

<sup>28</sup> *Wal-Mart*, 529 U.S. at 210 (quoting *Two Pesos*, 505 U.S. at 768) (internal quotation mark omitted).

<sup>29</sup> *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 1001 (2d Cir. 1997).

<sup>30</sup> *Wal-Mart*, 529 U.S. at 211 (quoting *Inwood Labs, Inc. v. Ives Labs, Inc.*, 456 U.S. 844, 851 n.11 (1982)) (internal quotation marks omitted); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 (1995) ("[A]s a result of its use, prospective purchasers have come to perceive it as a designation that identifies goods, services, businesses, or members.").

<sup>31</sup> *Cartier, Inc. v. Sardell Jewelry, Inc.*, 294 F. App'x 615, 618–19 (2d Cir. 2008).

<sup>32</sup> *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 115 (2d Cir. 2001) (citing *Wal-Mart*, 529 U.S. at 210).

The test for likelihood of confusion is "whether the public is likely to be deceived or confused by the similarity" of the two trade dresses.<sup>33</sup> Further, courts apply different sets of factors when determining likelihood of confusion. For instance, the Second Circuit applies the *Polaroid* test, which includes the following factors:

(1) the strength of the plaintiff's trade dress, (2) the similarity between the two trade dress, (3) the proximity of the products in the marketplace, (4) the likelihood that the prior owner will bridge the gap between the products, (5) evidence of actual confusion, (6) the defendant's bad faith, (7) the quality of defendant's product, and (8) the sophistication of the relevant consumer group.<sup>34</sup>

In *Cartier*, the court applied the *Polaroid* factors, holding that there was likelihood of confusion because both watches had close proximity in the marketplace, as they were both luxury watches.<sup>35</sup> Likelihood of confusion is an especially important element because it strikes at the heart of trade dress protection's purpose—"to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers."<sup>36</sup>

The final trade dress element is functionality. The Lanham Act will only protect non-functional features,<sup>37</sup> so a court must decide whether the feature "is essential to the use or purpose of the article or if it affects the cost or quality of the article."<sup>38</sup> If so, it cannot constitute protectable trade dress. Another way of analyzing functionality is to test whether the owner's exclusive use of the feature would put others at a non-reputation-related

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<sup>33</sup> *Two Pesos*, 505 U.S. at 780 (Stevens, J., concurring) (quoting *New West Corp. v. NYM Co. of Cal.*, 595 F.2d 1194, 1201 (9th Cir. 1979)).

<sup>34</sup> *Fun-Damental Too*, 111 F.3d at 1002-03 (citing *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961)). These factors have been applied outside of the Second Circuit. See Lisa M. Byerly, Comment, *Look and Feel Protection of Web Site User Interfaces: Copyright or Trade Dress?*, 14 SANTA CLARA COMPUTER & HIGH TECH. L.J. 221, 261 (1998) (discussing the frequent application of the *Polaroid* factors).

<sup>35</sup> *Cartier*, 294 F. App'x at 619.

<sup>36</sup> *Two Pesos*, 505 U.S. at 774 (quoting *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985)) (internal quotation mark omitted).

<sup>37</sup> *Yurman*, 262 F.3d at 116.

<sup>38</sup> *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 32 (2001) (quoting *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995)) (internal quotation mark omitted).

disadvantage.<sup>39</sup> For instance, the design of a watch was considered not functional because there were “many alternative designs that could perform the same function.”<sup>40</sup> In other words, that specific watch design was not the only design by which a watch may function. While these elements are used to establish traditional trade dress, there has been little guidance on how they should apply to internet cases.

## II. TRADE DRESS PROTECTION FOR WEBSITES

### A. *Background: What Is “Look and Feel” and Why Is it an Issue?*

Recently, plaintiffs have sought protection for their websites, claiming that a site’s overall “look and feel” can constitute protectable trade dress.<sup>41</sup> This is a “novel legal theory”<sup>42</sup> with “sparse case law”<sup>43</sup> and has yet to reach circuit courts.<sup>44</sup> “Look and feel” can refer to the “user interface, generally manifested by the display screens that a computer program generates and the keystroke combinations that are used for particular program functions . . . [and] include[s] color, clipart, graphics, designs, animation, and even sounds.”<sup>45</sup> For instance, a plaintiff may allege that the combination of its website’s text, colors, backgrounds, borders, and scrolls creates an overall “look and feel” that is protectable trade dress.<sup>46</sup> There can also be technical elements of internet trade dress.<sup>47</sup>

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<sup>39</sup> *Id.* (quoting *Qualitex*, 514 U.S. at 165).

<sup>40</sup> *Cartier*, 294 F. App’x at 621.

<sup>41</sup> See MCCARTHY, *supra* note 9, § 8:7.25.

<sup>42</sup> *Blue Nile, Inc. v. Ice.com, Inc.*, 478 F. Supp. 2d 1240, 1246 (W.D. Wash. 2007).

<sup>43</sup> *Conference Archives, Inc. v. Sound Images, Inc.*, Civil No. 3:2006-76, 2010 WL 1626072, at \*7 (W.D. Pa. Mar. 31, 2010).

<sup>44</sup> See, e.g., *id.* at \*14 (noting that this was an issue of “first impression” in the circuit); *Parker Waichman LLP v. Gilman Law LLP*, No. 12-CV-4784(JS)(AKT), 2013 WL 3863928, at \*4 (E.D.N.Y. July 24, 2013) (noting this “is an issue of first impression in this Circuit”); *Salt Optics, Inc. v. Jand, Inc.*, No. SACV 10-0828 DOC (RNBx), 2010 WL 4961702, at \*5 (C.D. Cal. Nov. 19, 2010) (“[T]he Ninth Circuit has yet to explicate the precise boundaries of trade dress law as applied to the internet.”).

<sup>45</sup> Amber R. Cohen, Note, *A Square Peg into a Round Hole: Trade Dress Protection of Websites, the Perspective of the Consumer and the Dilemma for the Courts*, 3 S. NEW ENG. ROUNDTABLE SYMP. L.J. 137, 154 (2008) (footnote omitted) (internal quotation mark omitted).

<sup>46</sup> *Salt Optics*, 2010 WL 4961702, at \*1, \*5 (discussing the plaintiffs’ allegations).

<sup>47</sup> See *Conference Archives*, 2010 WL 1626072, at \*4-5 (outlining the technical elements of a website’s “look and feel”). According to the Western District of



"Look and feel" for websites is a vague concept, and courts give little guidance on how it should apply. A lead case in the area of "look and feel" for websites is *Blue Nile, Inc. v. Ice.com, Inc.*<sup>48</sup> There, the Western District of Washington held that the "look and feel" of a website *could* constitute protectable trade dress.<sup>49</sup> Missing from its decision, however, is an explanation of why a website's "look and feel" can be considered trade dress. The court merely held that "look and feel" *can* constitute trade dress because it was a "novel legal theory," and the court was reluctant to dismiss the claim without further factual development.<sup>50</sup> Still, other district courts have followed suit by holding that claims for "look and feel" *could* constitute protectable trade dress.<sup>51</sup> But "[t]o state that something is *capable* of trade dress protection is hardly the same as concluding that it [is] likely to or has become valid and legally protectable trade dress."<sup>52</sup> Further, circuit courts have yet to weigh in on the issue, leaving uncertainty in the field.<sup>53</sup> The issue, therefore, is that few courts have actually explained how "look and feel" applies or constitutes trade dress; they have

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Pennsylvania, the technical elements of a web page are: (1) color, which consists of combinations so that up to 16,777,216 different colors can be created (meaning that calling something "blue" is not enough); (2) orientation, which stems from the pixel measurement of size on a computer screen and weighs the size and lay out of objects on a screen; and (3) code elements, which is how the computer code, such as Hyper Text Markup Language ("HTML"), is arranged. *Id.*

<sup>48</sup> 478 F. Supp. 2d 1240 (W.D. Wash. 2007). The court denied the defendant's motion to dismiss the claim based on preemption by the Copyright Act because "factual development [was] necessary" to determine which parts of the plaintiff's website would be protected. *Id.* at 1245. Because of the need for "factual development" when analyzing whether copyright law preempts trade dress law, this Note will not delve into that topic. *Id.* This Note does not deny that it is possible that copyright law could preempt trade dress law when it comes to protecting websites. Instead, it merely asserts that "look and feel" is an inappropriate solution to internet trade dress law. Further, *Blue Nile* is regarded as a leading example of allowing "look and feel" claims. See *Conference Archives*, 2010 WL 1626072, at \*5.

<sup>49</sup> *Blue Nile*, 478 F. Supp. 2d at 1246 (denying the motion to dismiss for need of greater factual development). The case, however, settled out of court and it was not decided whether the "look and feel" was actually protected. See *Conference Archives*, 2010 WL 1626072, at \*5.

<sup>50</sup> *Blue Nile*, 478 F. Supp. 2d at 1246.

<sup>51</sup> See *Salt Optics*, 2010 WL 4961702, at \*5 (collecting cases where district courts have said "look and feel" *can* constitute trade dress) (emphasis added).

<sup>52</sup> MCCARTHY, *supra* note 9, § 8:4.

<sup>53</sup> See, e.g., *Conference Archives*, 2010 WL 1626072, at \*14 (discussing the novelty of "look and feel" to the circuit).

merely decided not to rule it inapplicable.<sup>54</sup> The result is a vague concept, with little guidance on its application.<sup>55</sup> By analyzing the case law, the problems with “look and feel” become even more apparent.

### B. Internet Trade Dress Cases

This Section seeks to analyze several of the lead internet “look and feel” cases to find the problems with its application. It is divided into two parts: (1) courts that recognize “look and feel,” but fail to distinguish it from general trade dress, and (2) courts that recognize “look and feel,” but require pleading specifically what constitutes the websites’ “look and feel.” In the first part, courts blend the definition of “look and feel” and traditional trade dress. In the second part, courts negate their acceptance of “look and feel” by requiring that it be specifically described. Both complicate trade dress analyses by contradicting their allowance of “look and feel” in the first place.

#### 1. Cases Failing To Distinguish “Look and Feel” from General Trade Dress

##### a. Conference Archives, Inc. v. Sound Images, Inc.

In *Conference Archives, Inc. v. Sound Images, Inc.*,<sup>56</sup> the Western District of Pennsylvania held that “look and feel” can constitute trade dress, but analyzed “look and feel” of websites mostly in contrast to copyright law.<sup>57</sup> The court attempted to define “look and feel,” rather than discuss how it is properly applied.<sup>58</sup> In doing so, the court came up with two combined elements: (1) “visual design” and (2) “interface design,” which

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<sup>54</sup> See *Blue Nile*, 478 F. Supp. 2d at 1246 (declining to dismiss because the court needed greater factual development); see also *Conference Archives*, 2010 WL 1626072, at \*16 (noting that “look and feel” can constitute trade dress, but failing to devise a test); *Sleep Sci. Partners v. Lieberman*, No. 09-04200 CW, 2010 WL 1881770, at \*3 (N.D. Cal. May 10, 2010) (declining to disregard “look and feel,” but dismissing for lack of specificity).

<sup>55</sup> *Conference Archives*, 2010 WL 1626072, at \*7–8 (outlining several proposed definitions and applications of “look and feel,” but noting that “[n]o [c]ourt has adopted any of these definitions”).

<sup>56</sup> Civil No. 3:2006–76, 2010 WL 1626072.

<sup>57</sup> *Id.* at \*14 (discussing how trade dress and “look and feel” allowed a court to look at and protect changing and interactive elements of a website, unlike copyright law).

<sup>58</sup> *Id.*

both “encompass not only static elements such as particular photos, colors, borders or frames, but also interactive elements and the overall mood, style or impression of the site.”<sup>59</sup> The court reasoned that because of their flexibility, these elements are best protected by trade dress law, rather than by more rigid copyright laws.<sup>60</sup>

This analysis, however, ignores the question of how “look and feel” should be applied. Even if trade dress is well-suited for websites, this case failed to explain how “look and feel,” rather than just normal trade dress analyses, comes into play. One telling point, however, was the court’s assertion that “the definition of trade dress is broad, and is ‘essentially [a business’s] total image and overall appearance.’”<sup>61</sup> This seems to blend the term “look and feel” with the general definition of trade dress, which is “the composite tapestry of visual effects,” a problem with which other courts also struggle.<sup>62</sup>

b. *SG Services Inc. v. God’s Girls Inc.*

Although the opinion in *SG Services Inc. v. God’s Girls Inc.*<sup>63</sup> fails to use the term “look and feel” when discussing trade dress,<sup>64</sup> it is still considered under “look and feel” analysis because the plaintiff sought protection for the overall make-up of its website.<sup>65</sup> The plaintiff, a pornographic website, claimed that the defendant, also a pornographic website, infringed its trade dress by using the color pink and similar phrases.<sup>66</sup> The Central District of California analyzed the claim as if the website was any other product, combing through the trade dress elements of distinctiveness, likelihood of confusion, and functionality, and ultimately granted summary judgment for the defendant due to insufficiencies with the distinctiveness and likelihood of

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<sup>59</sup> *Id.* (quoting Fred H. Perkins & Alvin C. Lin, *What's Old Is New in Web Site Protection*, 7 INTERNET L. & STRATEGY 3 (2009)) (internal quotation marks omitted).

<sup>60</sup> *Id.*

<sup>61</sup> *Id.* at \*11 (alteration in original) (quoting *Blue Bell Bio-Medical v. Cin-Bad Inc.*, 864 F.2d 1253, 1256 (5th Cir. 1989)).

<sup>62</sup> *Sleep Sci. Partners v. Lieberman*, No. 09-04200 CW, 2010 WL 1881770, at \*3 (N.D. Cal. May 10, 2010) (quoting *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1259 (9th Cir. 2001)).

<sup>63</sup> No. CV 06-989 AHM (CTx), 2007 WL 2315437 (C.D. Cal. May 9, 2007).

<sup>64</sup> *See id.* at \*8–11.

<sup>65</sup> *See, e.g., Conference Archives*, 2010 WL 1626072, at \*6 (discussing *SG Servs.* in a “look and feel” analysis).

<sup>66</sup> *SG Servs.*, 2007 WL 2315437, at \*8.

confusion elements, based mostly on a thin record.<sup>67</sup> While this Note supports the court's analysis based on traditional elements, the decision shows the confusion "look and feel" causes. The plaintiff merely asserted that the color pink and several phrases constituted "look and feel," yet the court took until the summary judgment phase to dismiss the claim.<sup>68</sup>

## 2. Cases Allowing "Look and Feel," but Requiring Specificity

### a. Sleep Science Partners v. Lieberman

In *Sleep Science Partners v. Lieberman*,<sup>69</sup> the plaintiff alleged that the defendant infringed its trade dress by copying the "unique look and feel" of its website.<sup>70</sup> For instance, the plaintiff asserted that its website's "look and feel" consisted of its television commercial, testimonials, a questionnaire, and also the size and layout of text and graphics.<sup>71</sup>

The Northern District of California ultimately dismissed the plaintiff's claim, basing its holding on a lack of specificity in the complaint.<sup>72</sup> Noting that trade dress, in general, "involves 'the total image of a product and may include features such as size, shape, color or color combination, texture, graphics, or even particular sales techniques,'" <sup>73</sup> the court discussed the need to not focus on each individual element of a trade dress, but on "the overall visual impression that the combination and arrangement of those elements create."<sup>74</sup> Thus, the court noted, "[a] plaintiff should *clearly articulate* its claimed trade dress to give a defendant sufficient notice" and to avoid the risk of a plaintiff changing its purported trade dress later in the litigation.<sup>75</sup> Without specificity, the court was unwilling to allow "look and feel" to constitute trade dress, meaning that the plaintiff needed to allege more than just "look and feel"; it had to point to specific elements and explain how they combine to constitute the overall

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<sup>67</sup> *Id.* at \*8–11.

<sup>68</sup> *Id.* at \*8, \*11.

<sup>69</sup> No. 09-04200 CW, 2010 WL 1881770 (N.D. Cal. May 10, 2010).

<sup>70</sup> *Id.* at \*2 (internal quotation mark omitted).

<sup>71</sup> *Id.* at \*3.

<sup>72</sup> *Id.* at \*4.

<sup>73</sup> *Id.* at \*3 (quoting *Mattel Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 808 n.13 (9th Cir. 2003)).

<sup>74</sup> *Id.* (quoting *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1259 (9th Cir. 2001)) (internal quotation mark omitted).

<sup>75</sup> *Id.* (emphasis added).

"look and feel."<sup>76</sup> Absent from this holding is guidance on this standard. Rather, the court merely asked the plaintiff to "articulate more clearly what constitutes its trade dress."<sup>77</sup> This is hardly a workable standard.

b. *Salt Optics, Inc. v. Jand, Inc.*

Similar to the decision in *Sleep Science*, the court in *Salt Optics, Inc. v. Jand, Inc.*<sup>78</sup> dismissed the complaint for lack of specificity.<sup>79</sup> The plaintiff claimed that the "composite effect of several of the website's" elements, or the "look and feel," constituted its trade dress.<sup>80</sup> Although the Central District of California acknowledged that an overall "look and feel" claim for a website *can* be viable, it cautioned that there was an increased need for factual detail to support this type of claim because the changing nature of websites means that "the elements comprising a website's overall 'look and feel' can be more difficult to pin down" than products traditionally protected.<sup>81</sup> Thus, "a mere cataloguing of a website's features does not give defendants adequate notice of a plaintiff's trade dress claim."<sup>82</sup> The court, therefore, required the plaintiff to "synthesize" the individual elements constituting its "look and feel," rather than merely listing several elements and calling it "look and feel."<sup>83</sup>

C. *Problems with Internet Trade Dress Cases*

While not expressly disallowing "look and feel," *Conference Archives* and *SG Services* appear to effectively disregard the term "look and feel."<sup>84</sup> This Note proposes that the substantive analyses of these cases was correct, but that the courts erred by

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<sup>76</sup> *Id.* at \*4.

<sup>77</sup> *Id.*

<sup>78</sup> No. SACV 10-0828 DOC (RNBx), 2010 WL 4961702 (C.D. Cal. Nov. 19, 2010).

<sup>79</sup> *Id.* at \*5-6.

<sup>80</sup> *Id.* at \*5.

<sup>81</sup> *Id.*

<sup>82</sup> *Id.*

<sup>83</sup> *Id.*; see also *Parker Waichman LLP v. Gilman Law LLP*, No. 12-CV-4784(JS)(AKT), 2013 WL 3863928, at \*4 (E.D.N.Y. July 24, 2013) (dismissing the complaint for failing to sufficiently articulate what constituted a law firm's website's "look and feel").

<sup>84</sup> See *Conference Archives, Inc. v. Sound Images, Inc.*, Civil No. 3:2006-76, 2010 WL 1626072, at \*11 (W.D. Pa. Mar. 31, 2010); see also *SG Servs. Inc. v. God's Girls Inc.*, No. CV 06-989 AHM (CTx), 2007 WL 2315437, at \*8-11 (C.D. Cal. May 9, 2007).

giving “look and feel” teeth. Instead, the courts should have just done a traditional trade dress analysis without paying mind to the generic “look and feel” language used by the plaintiffs. Further, *Sleep Science* and *Salt Optics* illustrate the anomaly that is the current “look and feel” landscape—courts refuse to disallow “look and feel” claims, but then require a more specific articulation.<sup>85</sup> These issues show that employing the “look and feel” standard complicates a simple issue.

### III. DOING AWAY WITH “LOOK AND FEEL”

#### A. *The Solution: Ignore “Look and Feel” and Analyze Websites Traditionally*

While many district courts have not ruled out “look and feel,” they have yet to decide how it should apply.<sup>86</sup> In fact, such applications by the courts often stand contrary to allowing claims for “look and feel,” as they define general trade dress almost identically to how “look and feel” is often defined, and then apply the standard elements as if it were a run-of-the-mill trade dress case.<sup>87</sup> Or, courts require specificity as to what the “look and feel” is at the pleading stage, disregarding the broad, catch-all meaning of “look and feel.”<sup>88</sup> These analyses point to the flaws of allowing claims based on “look and feel” at all. Thus, courts should stop allowing plaintiffs to allege that the “look and feel” of their websites constitutes trade dress, and should instead require specification of the website’s trade dress and an explanation of how it satisfies the elements for plaintiffs who seek protection for the overall look of their websites.<sup>89</sup>

By suggesting that courts ignore the “look and feel” distinction, this Note is not suggesting that website trade dress

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<sup>85</sup> See, e.g., *Sleep Sci. Partners v. Lieberman*, No. 09-04200 CW, 2010 WL 1881770, at \*4 (N.D. Cal. May 10, 2010).

<sup>86</sup> See, e.g., *Blue Nile, Inc. v. Ice.com, Inc.*, 478 F. Supp. 2d 1240, 1246 (W.D. Wash. 2007).

<sup>87</sup> See *Conference Archives*, 2010 WL 1626072, at \*11 (defining trade dress in a similar manner to “look and feel”); see also *SG Servs.*, 2007 WL 2315437, at \*8–11 (analyzing “look and feel” by applying standard trade dress elements).

<sup>88</sup> See *Sleep Sci. Partners v. Lieberman*, No. 09-04200 CW, 2010 WL 1881770, at \*3 (N.D. Cal. May 10, 2010) (asking the plaintiff to specify its purported trade dress); see also *Salt Optics*, 2010 WL 4961702, at \*5 (requiring more specification than merely alleging “look and feel”).

<sup>89</sup> See *Sleep Sci.*, 2010 WL 1881770, at \*3; see also *Salt Optics*, 2010 WL 4961702, at \*5.

cases are invalid or that the overall look of a website may not be protected. Rather, this Note suggests that courts should accept website trade dress claims, but apply normal trade dress elements to them and stop allowing plaintiffs to merely allege that their trade dress is just “look and feel.” As discussed *supra*, courts have trouble handling cases in which the plaintiff merely alleges “look and feel.”<sup>90</sup> Thus, this solution seeks to remove that vexing phrase. Without the term “look and feel,” courts will merely ask plaintiffs to explain what constitutes their website’s trade dress, and then apply a normal trade dress analysis, which is what courts are doing anyway.<sup>91</sup> This solution, therefore, cuts out the “look and feel” middleman.

*B. Why Ignore “Look and Feel”? Problems and How Ignoring “Look and Feel” Helps*

1. Specification of Trade Dress

*Sleep Science* and *Salt Optics* illustrate the tension created by courts allowing plaintiffs to allege “look and feel” infringement while also requiring that trade dress be specified.<sup>92</sup> In both cases, the courts chose not to disallow “look and feel,” but dismissed the complaints because the plaintiffs failed to specify or synthesize the elements of their websites’ designs.<sup>93</sup> This result is absurd because the courts allowed the plaintiffs to “seek[] protection for the composite effect of several of the websites[] allegedly distinctive design elements and features,” or the “overall appearance[s] of their websites, by alleging that the “look and feel” was infringed,<sup>94</sup> but also asked them to “clearly

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<sup>90</sup> See *supra* Part II.

<sup>91</sup> See, e.g., *Salt Optics*, 2010 WL 4961702, at \*5 (asking the plaintiff to synthesize its trade dress).

<sup>92</sup> See *Sleep Sci.*, 2010 WL 1881770, at \*3; see also *Salt Optics*, 2010 WL 4961702, at \*5.

<sup>93</sup> See *Sleep Sci.*, 2010 WL 1881770, at \*3; see also *Salt Optics*, 2010 WL 4961702, at \*5; *Parker Waichman LLP v. Gilman Law LLP*, No. 12-CV-4784(JS)(AKT), 2013 WL 3863928, at \*4 (E.D.N.Y. July 24, 2013) (dismissing complaint because “the Complaint merely lists a few, but not all, of the features of [the plaintiff’s website] that it believes constitute its trade dress. The Complaint makes no attempt to synthesize those elements or even remotely address the other three elements of a claim for trade dress infringement”); *Keep A Breast Found. v. Seven Grp.*, No. 11-CV-00570 BEN (WMC), 2011 WL 3240756, at \*2 (S.D. Cal. July 28, 2011) (“That ‘look and feel’ can constitute trade dress, however, does not address the required specificity with which a product’s ‘look and feel’ must be alleged.”).

<sup>94</sup> *Salt Optics*, 2010 WL 4961702, at \*5.

articulate [their] claimed trade dress[es] to give . . . defendant[s] sufficient notice.”<sup>95</sup> Basically, the courts were asking the plaintiffs to elaborate on what created the “look and feel.” By allowing “look and feel,” but then requiring specification, the courts are not allowing general “look and feel” claims. If that is the case, plaintiffs should not be allowed to allege “look and feel” at all.

Specification of trade dress is an important part of both internet and traditional trade dress law. The Second Circuit, for instance, “stated that the ‘focus on the overall look of a product does not permit a plaintiff to dispense with an articulation of the specific elements which comprise its distinct dress.’”<sup>96</sup> Thus, a plaintiff must articulate what makes up the “overall look” of its product.<sup>97</sup> “[L]ook and feel” does not pass muster under the rule that trade dress must be defined with considerable particularity,<sup>98</sup> a rule which was stated in *Salt Optics*.<sup>99</sup> “Hazy and indefinite references to the protectable and allegedly infringed aspect of trade dress in a Web site as its ‘look and feel’ fall far short of the exactitude that is required” when alleging trade dress infringement.<sup>100</sup> Thus, rather than allow plaintiffs to allege “look and feel,” courts should require that they specify and explain what they believe constitutes their trade dress.

Requiring plaintiffs to specify exactly what they seek to protect has many important features. First, “litigation will be difficult, as courts will be unable to evaluate how unique and unexpected the design elements are in the relevant market,” if descriptions are vague.<sup>101</sup> Next, courts may have trouble trying to “shape narrowly-tailored relief if they do not know what distinctive combination of ingredients deserves protection.”<sup>102</sup>

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<sup>95</sup> *Sleep Sci.*, 2010 WL 1881770, at \*3.

<sup>96</sup> *Sherwood 48 Assocs. v. Sony Corp. of Am.*, 76 F. App’x 389, 391 (2d Cir. 2003) (quoting *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 381 (2d Cir. 1997)) (“[T]he [plaintiffs] plainly seek to protect the ‘overall look’ of each of the buildings, and yet they fail to identify the specific elements that comprise each building’s identifiable trade dress.”).

<sup>97</sup> *Landscape Forms*, 113 F.3d at 381. It should be noted that the court there also fell prey to the paradox of allowing “overall look” claims, but also requiring more specification. *Id.*

<sup>98</sup> MCCARTHY, *supra* note 9, § 8:7.25.

<sup>99</sup> *Salt Optics*, 2010 WL 4961702, at \*5.

<sup>100</sup> MCCARTHY, *supra* note 9, § 8:7.25.

<sup>101</sup> *Landscape Forms*, 113 F.3d at 381.

<sup>102</sup> *Id.*



Further, and perhaps most importantly, a plaintiff's failure to explain what its trade dress is "may indicate that its claim is pitched at an improper level of generality."<sup>103</sup> Moreover, specification serves to provide notice to defendants, allowing them to understand what it is that they allegedly infringed.<sup>104</sup> Thus, it is important to make sure that plaintiffs adequately specify how the features of their websites combine to create trade dresses. Merely alleging that the general "look and feel" of a website is its trade dress will not satisfy the specification requirement and "raises the danger of overprotection, with resulting anti-competitive injury to competitors."<sup>105</sup>

Denying the use of general "look and feel" allegations, but requiring specification of trade dress, will alleviate the paradox while dispelling courts' fears of overly general allegations. Thus, this solution is more effective than allowing "look and feel" and later struggling with its application.

## 2. "Product Line" Trade Dress Analogy

Requiring plaintiffs to specify how the features of their websites combine to create trade dress is akin to what courts have done in "product line" cases, a similar type of trade dress situation. In these types of cases, plaintiffs seek trade dress protection for a full line of products.<sup>106</sup>

For instance, a designer sought protection for a line of eighteen pieces of jewelry, consisting of rings, bracelets, and earrings, in *Yurman Design, Inc. v. PAJ, Inc.*<sup>107</sup> There, the plaintiff claimed that the "overall impression" of its designs embodied its trade dress, which was a "motif of twisted multi-strand cable, executed with a polished and elegant finish, and set

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<sup>103</sup> *Id.* Other reasons that vague descriptions of trade dress cause problems is because "different jurors viewing the same line of products may conceive the trade dress to be composed of different features" and "a narrowly tailored injunction cannot be framed." MCCARTHY, *supra* note 9, § 8:3.

<sup>104</sup> *Salt Optics*, 2010 WL 4961702, at \*5. Further, such imprecision and vagueness is unfair to the party accused of infringement who is forced to defend against an amorphous claim of exclusivity which is of uncertain and indeterminate dimensions. The law of trade dress should not be used as an anti-competitive weapon based upon undefined claims of "trade dress."

MCCARTHY, *supra* note 9, § 8:3.

<sup>105</sup> MCCARTHY, *supra* note 9, § 8:3.

<sup>106</sup> See *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 114 (2d Cir. 2001).

<sup>107</sup> *Id.*

off by gemstones.”<sup>108</sup> The Second Circuit held that the plaintiff had to “articulate the design elements that compose the trade dress.”<sup>109</sup> “Thus, the ‘focus on the overall look of a product [or products] does not permit a plaintiff to dispense with *an articulation of the specific elements* which comprise its distinct dress.’”<sup>110</sup> The court then explained the policy reasons for why an articulation of the elements comprising trade dress was necessary, including that: (1) jurors could conceive the trade dress of a product line differently without one; (2) jurors could not properly weigh the elements without knowing what exactly was to be protected; (3) a vague articulation indicates that the claim is improper; and (4) courts cannot narrowly tailor relief without knowing what exactly constituted the trade dress.<sup>111</sup>

Similarly, in *Landscape Forms, Inc. v. Columbia Cascade Co.*,<sup>112</sup> the plaintiff sought protection for a line of furniture.<sup>113</sup> In its complaint, the plaintiff merely asserted that “[t]he product design and configuration” of a line of its furniture “employs a number of distinctive elements” which combined to create a trade dress.<sup>114</sup> The Second Circuit was dissatisfied because those “‘distinctive elements’ [were] not enumerated,” and noted that “when protection is sought for an entire line of products, our concern for protecting competition is acute.”<sup>115</sup> Thus, the court held that the plaintiff failed to sufficiently specify the features of its product line.<sup>116</sup>

Product line cases and website cases are substantially similar. In both instances, plaintiffs are seeking to protect an “overall impression” created by multiple elements.<sup>117</sup> For product line cases, it may be a line of rings, bracelets, and earrings, while for websites, it may be the colors, fonts, coding, and orientation. Further, the concerns asserted by the *Yurman* court apply to

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<sup>108</sup> *Id.*

<sup>109</sup> *Id.* at 116.

<sup>110</sup> *Id.* at 117 (quoting *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 381 (2d Cir. 1997)) (alteration in original).

<sup>111</sup> *Id.* The *Yurman* court granted the defendant’s motion for judgment as a matter of law because the plaintiff “failed to identify the specific elements of its trade dress.” *Id.* at 118.

<sup>112</sup> 113 F.3d 373 (2d Cir. 1997).

<sup>113</sup> *Landscape Forms*, 113 F.3d at 381.

<sup>114</sup> *Id.* (alteration in original) (internal quotation mark omitted).

<sup>115</sup> *Id.* at 381, 380.

<sup>116</sup> *Id.* at 382.

<sup>117</sup> *Yurman*, 262 F.3d at 114.

both types of cases.<sup>118</sup> For websites, different jurors could interpret the “look and feel” of a website differently or have trouble deciding the likelihood of confusion or distinctiveness elements because some may look more at colors while others may look more at orientation.<sup>119</sup> Moreover, like product lines, websites are less static than traditional trade dress cases,<sup>120</sup> such as the restaurant décor in *Two Pesos*.<sup>121</sup>

Because product lines and websites are similar, they should both require an articulation of the specific elements making up their trade dresses. Although product line cases have allowed the “overall look” to be protected,<sup>122</sup> they suffer from the same paradox as website cases—requiring specification is basically an admission that “look and feel” is insufficient.<sup>123</sup> Thus, this Note focuses on the specification requirement discussed in product line cases, rather than their acceptance of “overall look.” This will relieve the concerns articulated by product line courts, as well as rectify the problems discussed in the previous Section.

### 3. Different Web Interfaces

“In the non-virtual world, most, if not all, trade dress remains the same to all consumers regardless of the location of the consumers or distribution point.”<sup>124</sup> Thus, a tricky factor for the trade dress of websites is that they can be viewed from multiple platforms.

A web site with pages uniquely displayed, as intended, on the monitor of one computer may have a different result on another computer. This may affect the overall look and feel of the web site and subsequently the experience of consumers visiting the site. The visitors, depending on the size and resolution of their

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<sup>118</sup> See *id.* at 117.

<sup>119</sup> *Id.*

<sup>120</sup> See *Conference Archives, Inc. v. Sound Images, Inc.*, Civil No. 3:2006-76, 2010 WL 1626072, at \*14 (W.D. Pa. Mar. 31, 2010) (describing the “interactive elements” of a website (internal quotation mark omitted)).

<sup>121</sup> See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 (1992).

<sup>122</sup> See *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 381 (2d Cir. 1997) (internal quotation marks omitted).

<sup>123</sup> See *id.*

<sup>124</sup> Xuan-Thao N. Nguyen, *Should It Be a Free for All? The Challenge of Extending Trade Dress Protection to the Look and Feel of Web Sites in the Evolving Internet*, 49 AM. U. L. REV. 1233, 1251 (2000).

computer screens, may not experience the same look and feel of the site as intended by the web site designer.<sup>125</sup>

Moreover, users may have different browsers, which can have different colors, layouts, and features that affect how the website is viewed.<sup>126</sup> Further, the proliferation of smart phones adds yet another way to view webpages. Thus, the “look and feel” of a website is “difficult to pin down.”<sup>127</sup>

These factors make the use of the term “look and feel” even more vague than in the product line examples, increasing the need for an articulation of trade dress. By allowing plaintiffs to merely allege “look and feel” without specificity, plaintiffs receive unregistered protection for something nearly impossible to define, which strikes at the heart of the competitive nature of the Lanham Act.<sup>128</sup>

Also, the changeable nature of websites does not demand the use of the vague allegation of “look and feel.”<sup>129</sup> While websites may be harder to describe than physical products, allowing vague “look and feel” allegations still defeats the purpose of the Lanham Act, which is to “promote fair competition.”<sup>130</sup> Further, that website trade dress is hard to describe could be an indication that it should not be protected in that circumstance, rather than an excuse to lessen the burden on plaintiffs.<sup>131</sup> If plaintiffs cannot properly articulate what their trade dress is, a jury or defendant could have the same problem.

Another issue with different web interfaces is that purely web-based businesses and “brick and mortar” businesses may both have websites. In the case of a “brick and mortar” business, it seems less likely that trade dress protection should apply at all. For instance, in *Parker Waichman LLP v. Gilman Law*

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<sup>125</sup> *Id.* at 1250 (footnote omitted).

<sup>126</sup> *See id.* at 1251–52.

<sup>127</sup> *Salt Optics, Inc. v. Jand, Inc.*, No. SACV 10-0828 DOC (RNBx), 2010 WL 4961702, at \*5 (C.D. Cal. Nov. 19, 2010).

<sup>128</sup> *See Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 380 (2d Cir. 1997) (discussing the Lanham Act’s pro-competition nature).

<sup>129</sup> *Conference Archives, Inc. v. Sound Images, Inc.*, Civil No. 3:2006-76, 2010 WL 1626072, at \*14 (W.D. Pa. Mar. 31, 2010).

<sup>130</sup> *See* 145 Cong. Rec. S8205 (daily ed. July 12, 1999) (statement of Sen. Reid).

<sup>131</sup> *See Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 117 (2d Cir. 2001) (explaining that “a plaintiff’s inability to explain to a court exactly which aspects of its product design(s) merit protection may indicate that its claim is pitched at an improper level of generality” (quoting *Landscape Forms*, 113 F.3d at 381) (internal quotation mark omitted)).

*LLP*,<sup>132</sup> the court “seriously question[ed]” whether the plaintiff’s purported “look and feel” could actually satisfy the elements of trade dress.<sup>133</sup> There, the plaintiff alleged that another law firm copied one of its websites, but the plaintiff had over one hundred websites for its firm, most of which did not share similar features.<sup>134</sup> Thus, the Eastern District of New York doubted that the one website alleged to be infringed could have acquired secondary meaning.<sup>135</sup> Had the law firm been purely web-based, the acquisition of secondary meaning may have been more likely, because clients might only have visited that website when establishing contact with the firm. These issues, however, are very fact specific and difficult to apply with a bright-line rule. Thus, applying normal trade dress analyses to website trade dress cases is especially appropriate.

#### 4. Lack of Registration

Another issue resulting from allowing “look and feel” claims stems from the ability of trade dress to be protected without registration.<sup>136</sup> “The case law decided under § 43(a) [of the Lanham Act] has broadened the scope of what is protectable as a trade dress, so Web site user interfaces have a better chance of being protected under § 43(a).”<sup>137</sup>

While this is a boon for plaintiffs, who can get protection without registering their websites’ trade dress, allowing plaintiffs to merely claim that the “look and feel” of their websites, which are not static and are hard to “pin down,”<sup>138</sup> was infringed, can “hamper efforts to market competitive goods.”<sup>139</sup> Simply put, plaintiffs would be able to get protection for trade dress without registering and without being specific in their complaints. Further, “copying is not always discouraged or disfavored by the

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<sup>132</sup> No. 12-CV-4784(JS)(AKT), 2013 WL 3863928 (E.D.N.Y. July 24, 2013).

<sup>133</sup> *Id.* at \*4 n.3.

<sup>134</sup> *Id.* at \*1, \*4 n.3.

<sup>135</sup> *Id.* at \*4 n.3.

<sup>136</sup> See *Conference Archives, Inc. v. Sound Images, Inc.*, Civil No. 3:2006-76, 2010 WL 1626072, at \*10 (W.D. Pa. Mar. 31, 2010).

<sup>137</sup> Byerly, *supra* note 34, at 251–52 (noting that trade dress does not have to be registered).

<sup>138</sup> *Salt Optics, Inc. v. Jand, Inc.*, No. SACV 10-0828 DOC (RNBx), 2010 WL 4961702, at \*5 (C.D. Cal. Nov. 19, 2010).

<sup>139</sup> See *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 380 (2d Cir. 1997).

laws which preserve our competitive economy.”<sup>140</sup> Thus, because of the unregistered nature of trade dress, allowing broad claims for “look and feel” can be anti-competitive, so the need to avoid “look and feel” and articulate what is protected is increased.

### C. *Test Suite*

This Section seeks to test the proposed solution on previously decided cases. The tests reveal that the proposed solution will cause the cases to come out correctly and with less confusion among the different courts.

#### 1. *Salt Optics, Inc. v. Jand, Inc.*

##### *In Salt Optics,*

Plaintiff list[ed] seven aspects of Defendant’s website that allegedly mimic[ked] Plaintiff’s site. First, Defendant utilized “saltwater blue” text offset against black and grey text, which is identical to Plaintiff’s website. Second, the background borders of both websites are blue and grey against a white foreground. Third, the websites present and organize their eyeglasses in a similar way. Fourth, both websites utilize models who wear the glasses consumers choose to see modeled. Fifth, both websites include a magnification tool. Sixth, on both websites consumers can choose to see a pair of glasses in a close-up photo with a small inset of the model wearing the glasses. On each site, this inset of the model contains two poses, one profile and the other head-on. Finally, Plaintiff avers that both websites feature the company’s logo in the upper left-hand corner of the screen.<sup>141</sup>

These allegations are noticeably more detailed than the allegations in *Sleep Science* below.<sup>142</sup> But several problems nevertheless exist under a traditional trade dress analysis, which is the proposed solution. First, and most importantly, the plaintiff does not describe or specify what constitutes its trade dress, unlike in *Two Pesos*, where the plaintiff explicitly described its trade dress as:

[A] festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals. The patio includes interior and exterior areas with the

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<sup>140</sup> *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001).

<sup>141</sup> *Salt Optics*, 2010 WL 4961702, at \*1.

<sup>142</sup> *Compare Sleep Sci. Partners v. Lieberman*, No. 09-04200 CW, 2010 WL 1881770, at \*3 (N.D. Cal. May 10, 2010), with *Salt Optics*, 2010 WL 4961702, at \*1.

interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building is a festive and vivid color scheme using top border paint and neon stripes. Bright awnings and umbrellas continue the theme.<sup>143</sup>

Conversely, Salt Optics merely lists characteristics of the defendant's website, which may or may not imitate its own "trade dress." Without explaining how these elements come together to form trade dress, it is nearly impossible for the jury, court, or defendant to understand what the plaintiff is attempting to protect.<sup>144</sup> The language of limitation<sup>145</sup> could further confuse the jury, court, and defendant, because, again, the plaintiff is not firmly saying what constitutes its trade dress.<sup>146</sup>

Second, a number of components Salt Optics sets out would be considered functional, making them ineligible for trade dress protection.<sup>147</sup> The magnification tool and the model's profile and head-on poses while displaying the glasses, for example, enhance the customer's eyeglass shopping experience; they cannot be deemed "nonfunctional" in the way that the "artifacts, bright colors, paintings and murals" or the "overhead garage doors . . . neon stripes[,] . . . awnings and umbrellas" were in *Two Pesos*.<sup>148</sup>

In fact, the only arguably non-functional, distinctive elements of the website Salt Optics includes in its complaint are the "'saltwater blue' text offset against black and grey text," and the background borders, which are blue and grey against a white foreground.<sup>149</sup> But it is far from clear that the color of the text and background borders would be sufficient to create "a likelihood of confusion on the part of ordinary customers as to the

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<sup>143</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 (1992) (quoting *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1117 (5th Cir. 1991)) (internal quotation marks omitted).

<sup>144</sup> See *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 117 (2d Cir. 2001).

<sup>145</sup> See *Salt Optics*, 2010 WL 4961702, at \*5.

<sup>146</sup> See *Yurman*, 262 F.3d at 117 (outlining issues with unspecific trade dress allegations).

<sup>147</sup> *Contra Cartier, Inc. v. Sardell Jewelry, Inc.*, 294 F. App'x 615, 621 (2d Cir. 2008) (holding that a watch design was not functional because there were "many alternative designs that could perform the same function").

<sup>148</sup> *Two Pesos*, 505 U.S. at 765 (quoting *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1117 (5th Cir. 1991)).

<sup>149</sup> *Salt Optics*, 2010 WL 4961702, at \*1.

source or association of the [defendant's] goods or services."<sup>150</sup> Thus, although closer to stating a cognizable claim than the complaint in *Sleep Science*, this claim would fail under the proposed solution.

## 2. *Sleep Science Partners v. Lieberman*

In *Sleep Science*,

Plaintiff [sought] protection of its website's "unique look and feel." It plead[ed] that its website's features "include (1) the ability to view SSP's television commercial; (2) user testimonials; (3) the screening questionnaire; and (4) the PureSleep Method." It also alleges that other components of the website's "design, look and feel are more subtle including, but not limited to, the size and location of text, the size and location of graphics, the features that it offers and the location of hyperlinks of those features." Plaintiff then describe[d] several other website design elements.<sup>151</sup>

Under the proposed solution, the court would ignore the "unique look and feel" phrase and just look at the specifics of the purported trade dress. A hypothetical court would be dissatisfied with the lack of specificity.<sup>152</sup> For instance, the plaintiff alleged that the website's trade dress includes "the size and location of text, the size and location of graphics, the features that it offers and the location of hyperlinks of those features."<sup>153</sup> This is extremely vague. At no point has the plaintiff described any of these features, which would make it difficult to apply to the elements of trade dress infringement.<sup>154</sup> A jury cannot decide if "the features that it offers and the location of hyperlinks of those features"<sup>155</sup> are distinctive, non-functional, or likely to cause confusion among consumers. Further, as the court held in *Sleep Science*, the defendants would not be given sufficient notice.<sup>156</sup> The Northern District of California was also wary of this

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<sup>150</sup> *Two Pesos*, 505 U.S. at 766; see *Cartier*, 294 F. App'x at 619 (holding that there was a likelihood of confusion because two luxury watches had close proximity in the marketplace, among other factors).

<sup>151</sup> *Sleep Sci. Partners v. Lieberman*, No. 09-04200 CW, 2010 WL 1881770, at \*3 (N.D. Cal. May 10, 2010) (citations omitted).

<sup>152</sup> See *id.* (requiring more specificity).

<sup>153</sup> *Id.* (internal quotation mark omitted).

<sup>154</sup> See *Yurman Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 117 (2d Cir. 2001).

<sup>155</sup> *Sleep Sci.*, 2010 WL 1881770, at \*3 (internal quotation mark omitted).

<sup>156</sup> *Id.*



language of limitation, as it felt the plaintiff's use of the phrase "including, but not limited to" showed that "these components [were] only some among many."<sup>157</sup>

Moreover, those elements listed fail to meet the elements of trade dress. For instance, "the size and location of text, the size and location of graphics, the features that it offers and the location of hyperlinks of those features," are hardly distinctive.<sup>158</sup> Further, font sizes do not seem to be likely to confuse a consumer when weighed against the *Polaroid* factors.<sup>159</sup> Thus, this complaint would be dismissed. To succeed, the plaintiff may have tried describing, in detail, what these features, colors, and graphics are, and how they "synthesize" to create a protectable trade dress and satisfy the elements.<sup>160</sup>

### 3. Findings

In both analyses, the hypothetical court would have come to the same conclusion as the actual courts, without the confusion of allowing "look and feel," but instead dismissing for other reasons. The hypothetical courts would ignore the catch-all phrases and focus on what the plaintiffs did to put the defendants on notice. Typically, this will result in the dismissal of vague complaints, which will promote more specificity in the future. Therefore, this Note proposes that once a court ascertains what a plaintiff seeks to protect, it should apply the elements to the alleged trade dress, similar to how a court would analyze the Mexican restaurant hypothetical discussed in the Introduction.

### CONCLUSION

The Lanham Act was drafted to "promote fair competition"<sup>161</sup> and to "secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish

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<sup>157</sup> *Id.*

<sup>158</sup> *Id.*; see *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 1001 (2d Cir. 1997) (internal quotation mark omitted) (holding that the Toilet Bank was distinctive because the "impression" conveyed by its elements helped to identify its source).

<sup>159</sup> See *Fun-Damental Too*, 111 F.3d at 1002–03.

<sup>160</sup> See *Salt Optics, Inc. v. Jand, Inc.*, No. SACV 10-0828 DOC (RNBx), 2010 WL 4961702, at \*5 (C.D. Cal. Nov. 19, 2010).

<sup>161</sup> 145 Cong. Rec. S8205 (daily ed. July 12, 1999) (statement of Sen. Reid).

among competing producers.”<sup>162</sup> Allowing plaintiffs to allege that the overall “look and feel” of their websites should be protectable trade dress “raises the danger of overprotection, with resulting anti-competitive injury to competitors,”<sup>163</sup> by giving plaintiffs a chance to get unregistered protection for generic designs.<sup>164</sup> Further, allowing “look and feel” has created absurd results, as courts are letting “look and feel” in while simultaneously knocking it out by requiring more specificity.<sup>165</sup>

Thus, ignoring the “look and feel” distinction and instead focusing on the elements of plaintiffs’ websites that come together to create their trade dresses, while requiring a specification of such, serves to alleviate the absurdity and limit the confusion caused by current “look and feel” cases. It also decreases the chance of “overprotection” by not granting registration to generic claims.<sup>166</sup>

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<sup>162</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992) (quoting *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985)) (internal quotation mark omitted).

<sup>163</sup> MCCARTHY, *supra* note 9, § 8:3.

<sup>164</sup> *See Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 380 (2d Cir. 1997).

<sup>165</sup> *See Sleep Sci. Partners v. Lieberman*, No. 09-04200 CW, 2010 WL 1881770, at \*3 (N.D. Cal. May 10, 2010); *see also Salt Optics*, 2010 WL 4961702, at \*5 (C.D. Cal. Nov. 19, 2010).

<sup>166</sup> MCCARTHY, *supra* note 9, § 8:3.

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